

REMARKS

Introduction

In view of at least the above amendments and the following remarks, applicants request reconsideration and withdrawal of the rejections set forth in the Office Action and allowance of the pending claims.

Interview Summary

Applicants wish to thank Examiner Ebersman for the courtesy of a telephone interview conducted on March 11, 2010. Participating on behalf of the applicants were the undersigned representative and Michael Dukes (Reg. No. 59,878). During the interview, the participants discussed the rejections under 35 U.S.C. § 103 based on the cited references and the instances of Official Notice cited in the Office Action. While no agreement was reached during the interview, applicants have attempted herein to address the issues raised in the interview.

Claim Rejections under 35 U.S.C. §101

Claim 42 stands rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. As suggested by the examiner, Claim 42 has been amended to recite, in part, a computer-readable medium containing executable code. Accordingly, applicants request withdrawal of this rejection.

Claim Rejections under 35 U.S.C. §103(a)

The Patent and Trademark Office updated the MPEP in light of the Supreme Court's decision in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007), to include guidelines for determining obviousness under §103(a) ("Guidelines"). As noted in the Guidelines, the four factual inquiries used in *Graham v. John Deere Co.*, 383 U.S. 1 (1966), should be followed when considering obviousness under §103(a), including:

- (A) Determining the scope and content of the prior art;
- (B) Ascertaining the differences between the prior art and the claims at issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

See MPEP § 2141(II). Objective evidence or secondary considerations such as unexpected results, commercial success, long-felt need, failure of others, copying by others, licensing, and skepticism of experts are relevant to the issue of obviousness and must be considered in every case in which they are present. When evidence of any of these secondary considerations is submitted, the examiner must evaluate the evidence. See MPEP § 2141.

As noted in MPEP § 706.02(j) (entitled "Contents of a 35 U.S.C. 103 Rejection"):

To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. (quoting *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985)).

Also, as stated in MPEP § 2142, entitled "Legal Concept of Prima Facie Obviousness":

The legal concept of prima facie obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in each step of the examination process. . . The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.

To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person.

In addition, as noted in MPEP § 2143.01 (entitled, "Suggestion or Motivation To Modify the References"):

IV. MERE STATEMENT THAT THE CLAIMED INVENTION IS WITHIN THE CAPABILITIES OF ONE OF ORDINARY SKILL IN THE ART IS NOT SUFFICIENT BY ITSELF TO ESTABLISH PRIMA FACIE OBVIOUSNESS - A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396 quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).

The Office bears the initial burden of factually supporting any rejection based on obviousness. If the Office does not establish a *prima facie* case, then the applicant is under no obligation to submit evidence of nonobviousness. MPEP § 2142.

For at least the following reasons, applicants respectfully submit that the Office Action has not established a *prima facie* case of obviousness against the pending claims, as amended, because the cited references and Official Notice, either individually or collectively, fail to teach, disclose or suggest each and every element recited in the amended claims.

Claims 1, 41, and 42

First, Claims 1, 41, and 42 have been amended to recite the subject matter of Claim 38. Claim 38 has been rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent Publication 2003/10078794 to Lewis in view of U.S. Patent Publications 2003/0078794 to Knapp and 2001/0034680 to Purcell in further view of U.S. Patent 6,853,974 to Akifuji. Applicants traverse this rejection for at least the reasons set forth herein.

Applicants respectfully submit that the proposed combination of Lewis, Purcell, Knapp, and Akifuji fails to teach or suggest a method for managing corporate action information of at least one entity comprising, in part, displaying a position status associated with at least a portion of said corporate action data, as recited in Claim 1, as amended. The Office Action characterizes Akifuji as teaching “a response status feature (col. 5, lines 5-40) where status is recorded in the data system and tracked.” Office Action, page 23. Applicants submit that Akifuji teaches that “the status watcher 90 reads attribute names from the business status definition table 10 and sets attributes of application data base 80 to be monitored (steps 7000,

7010 and 7020),... Attributes representing business identification number, start of estimation, completion of estimation are monitored.” Akifuji, col. 5, lines 5-39. Applicants submit that the attributes representing business identification number, start of estimation, and completion of estimation do not teach or suggest displaying a position status associated with at least a portion of said corporate action data. One example of “position” is described in paragraph [0056] of the application, where it is noted that “‘position’ is ownership of securities of an entity, which ownership can be considered as ‘holding’ a ‘position’ with respect to the entity.” Applicants submit that the attributes representing business identification number, start of estimation, and completion of estimation do not teach or suggest ownership of securities of an entity. The Office Action fails to cite any portion of Lewis, Purcell, or Knapp that cures this deficiency. Accordingly, the applicants submit that the Office Action has failed to establish a *prima facie* case of obviousness with regard to amended Claim 1.

Applicants respectfully submit that the proposed combination Lewis, Purcell, Knapp, and Akifuji fails to teach or suggest a method for managing corporate action information of at least one entity comprising, in part, wherein said position status compares the current status of said corporate action data to the status of said corporate action data when said notification is communicated as recited in Claim 1, as amended. The Office Action characterizes Lewis, Purcell, and Knapp as failing to teach position status measuring and communication and a status response feature. Office Action, page 23. Among other elements, applicants submit that Akifuji fails to teach or suggest “position status.” Akifuji teaches that the business status can be “start of inquiry”, “completion of inquiry”, “start of estimation”, and “completion of estimation.” Akifuji, col. 5, lines 5-39. The application describes “position status” in paragraph [0134],

where it is noted that “The ‘Position Status’ column which shows the current status of the position as it compares to the position when the last notification was sent. The position status can be increased, decreased, new, or unchanged.” Applicants submit that the business status of Akifuji does not teach or suggest “position status” which can be one of increased, decreased, new, or unchanged. The Office Action fails to cite any portion of Lewis, Purcell, or Knapp that cures this deficiency. Accordingly, applicants submit that the Office Action has failed to establish a *prima facie* case of obviousness with regard to amended Claim 1.

Second, Claim 1 has been amended to recite the subject matter of now canceled Claim 25. Claim 25 had been rejected under 35 U.S.C. § 103(a) as obvious over Lewis in view of Knapp and Purcell in further view of U.S. Patent Publication 2002/0049705 to Haviv-Segal et al. Applicants respectfully traverse this rejection for at least the reasons set forth herein.

Applicants respectfully submit that the proposed combination of Lewis, Knapp, Purcell, and Haviv-Segal fails to teach or suggest a method comprising, in part, associating a new source category with at least a position of said corporate action data, wherein said new source category includes a new source announcement that generates updates or discrepancies, as recited in Claim 25. The Office Action characterizes Haviv-Segal as disclosing “a method for creating content oriented databases and content files with a new source category (page 7, paragraph 0084, via tagging every new source).” Office Action, page 27. In the response filed on March 18, 2009, applicants amended Claim 25 to recite a method comprising, in part, “wherein said new source category includes a new source announcement that generates updates or discrepancies.” The Office Action fails to identify any portions of Lewis, Knapp, Purcell, or Haviv-Segal that teach or suggest a method comprising, in part, wherein said new source

category includes a new source announcement that generates updates or discrepancies.

Accordingly, applicants submit that the Office Action has failed to establish a *prima facie* case of obviousness with regard to amended Claim 1.

Claims 41 and 42 have been amended to recite the subject matter of Claims 38 and 25. Applicants submit that none of the cited references, either individually or collectively, teach, disclose or suggest all of the elements of Claims 41 and 42, respectively, for at least the reasons stated above with respect to Claim 1.

Claims 3, 4, 7-30 and 32-40

Applicants submit that none of the cited references, either individually or collectively, teach, disclose or suggest all of the elements of Claims 3, 4, 7-30 and 32-40, which depend, directly or indirectly, from Claim 1, for at least the reasons stated above with respect to Claim 1. See MPEP § 2143.03. Accordingly, applicants respectfully submit that the Office Action has failed to establish a *prima facie* case of obviousness with regard to Claims 3, 4, 7-30 and 32-40.

Claims 13, 16, 17, 19-22, 30, 32, and 33

Claims 13, 16, 17, 19-22, 30, 32, and 33 have been rejected under 35 U.S.C. § 103(a) as obvious over Lewis, Knapp, Purcell and Official Notice and/or applicant admitted prior art. As stated in previous responses, applicants maintain that the use of Official Notice is improper because the Official Notice asserted in the previous Office Action was adequately traversed.

Claim 12 has been rejected under 35 U.S.C. § 103(a) as obvious over Lewis, Knapp, Purcell and Lupien in further view of Official Notice. Claims 21, 22 and 30 have been rejected under 35 U.S.C. § 103(a) as obvious over Lewis, Knapp, Purcell and Official Notice. For purposes of all Official Notice instances arising in the Office Action, applicants would like to direct attention to §2144.03 of the MPEP (entitled "Reliance on Common Knowledge in the Art or 'Well Known' Prior Art"), which states:

Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known . . . the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), in turn citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).

....

C. If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or Not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding With Adequate Evidence.

Applicants respectfully submit that the instances of Official Notice cited in the Office Action are improper because the facts beyond the record are not well-known or so common knowledge in the art to be capable of instant and unquestionable demonstration as being well-known.

Specifically, applicants submit that the combination of elements recited in each of Claims 12, 21, 22 and 30, which depend directly or indirectly from Claim 1, are not properly

rejected under the Official Notice doctrine. The amendment to Claim 1 in combination with the elements recited in each of Claims 12, 21, 22 and 30 create subject matter that is not well-known or so common knowledge in the art to be capable of instant and unquestionable demonstration as being well-known. With regard to Claim 12, applicants submit that in a financial institution, a method for managing corporate action information including financial investment information of a particular security of at least one entity, the method comprising, in part, incorporate grouping at least a portion of data included within said end-of-the-day report by a designation selected from the group consisting of a user name, a category, an action type, a CASPR ID, a CUSIP, and a CUSIP would not be considered to be common knowledge or well-known in the art. With regard to Claim 21, applicants submit that in a financial institution, a method for managing corporate action information including financial investment information of a particular security of at least one entity, the method comprising, in part, associating an over-committed category with at least a portion of said corporate action data having at least one position that is less than the total response value for said position would not be considered to be common knowledge or well-known in the art. With regard to Claim 22, applicants submit that in a financial institution, a method for managing corporate action information including financial investment information of a particular security of at least one entity, the method comprising, in part, associating an under-committed category with at least a portion of said corporate action data having at least one position that is more than the total response value for said position would not be considered to be common knowledge or well-known in the art. With regard to Claim 30, applicants submit that in a financial institution, a method for managing corporate action information including financial investment information of a particular security of at least one entity, the method comprising, in

part, associating a new holders category with at least a portion of said corporate action data having at least one of a new holder and a new position would not be considered to be common knowledge or well-known in the art.

Accordingly, applicants request: (i) production of an appropriate reference or declaration corresponding to each use of Official Notice in the Office Action, or (ii) withdrawal of the obviousness rejection with respect to Claims 12, 21, 22 and 30.

Reservation of Arguments

Applicants do not concede the correctness of the Office Action rejections with respect to any of the independent or dependent claims. Applicants reserve the right to make additional or supplemental arguments as may be necessary because the independent and dependent claims include additional features that further distinguish the claims from the cited references. A detailed discussion of these differences is unnecessary at this stage in view of the fundamental distinctions pointed out above. Applicants do not acquiesce to any of the specific rejections, assertions, and statements presented in the Office Action that have not been explicitly addressed herein. Applicants reserve the right to specifically address all such rejections, assertions, and statements in continuing applications, subsequent responses, and in appeal or pre-appeal proceedings.

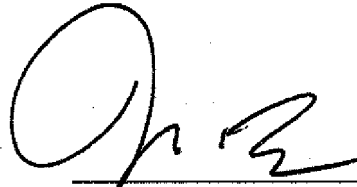
Amendments made herein are made without prejudice or disclaimer to the subject matter of the claims as originally filed. Furthermore, applicants do not acquiesce or otherwise concede the correctness of the rejections to the previously presented claims. Accordingly, applicants hereby reserve the right to pursue the subject matter of the claims as previously

presented or as originally filed in the application in related applications that may be currently on file or filed at a later date. Moreover, applicants hereby reserve the right to submit in such related applications arguments made in connection with the application. These amendments are solely made to expedite the prosecution of the application.

CONCLUSION

Applicants request reconsideration of the Office Action rejections and allowance of the pending claims of the application. To expedite prosecution of the application, applicants request a supplemental interview. Any questions regarding the present response are invited to the attention of the undersigned representative.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'M. Lazzara', is written over a horizontal line.

Michael D. Lazzara
Reg. No. 41,142

K&L GATES LLP
K&L Gates Center
210 Sixth Avenue
Pittsburgh, Pennsylvania 15222-2613

Telephone: (412) 355-8994
Fax: (412) 355-6501
E-mail: michael.lazzara@klgates.com